

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Catherine LIN-HENDELSer. No.: **09/833,956**Filed: **April 12, 2001**For: **SYSTEM AND METHOD FOR LIST
SHOPPING OVER A COMPUTER
NETWORK**Group Art Unit: **3621**Examiner: **John M. WINTER**Attorney File No.: **LH 011**Confirmation No.: **3820**Final Office Action Mailed On: **9/20/2007**Notice of Appeal Filed On: **12/21/2007**

**APPEAL BRIEF TO THE
BOARD OF PATENT APPEALS AND INTERFERENCES**

This Appeal Brief requests review of the rejections in the Final Office Action mailed on September 20, 2007, in the above-referenced patent application. Notice of Appeal in this case was received by the Office on December 21, 2007. The Appeal Brief is being filed within two months of that date and therefore is timely. If the undersigned attorney is mistaken regarding timeliness of the Appeal Brief, Applicant conditionally petitions for an appropriate extension of time, and authorization is hereby granted to charge the time extension fee required for filing the Appeal Brief to Deposit Account Number 50-3196. Authorization is also granted to charge to the same Deposit Account the small entity Appeal Brief fee (37 C.F.R. § 41.20(b)(2)), and all other fees necessary to file this Appeal Brief.

I
REAL PARTY IN INTEREST

In this Appeal, the real party in interest is Dr. Catherine Lin-Hendel, an individual.

II
RELATED APPEALS AND INTERFERENCES

Applicant-Appellant and the undersigned attorney do not know of any other appeal, interference, or judicial proceeding that is related to, directly affects, is directly affected by, or has a bearing on the decision of the Board of Patent Appeals and Interferences in this Appeal.

III
STATUS OF CLAIMS

The status of claims in the instant application is as follows:

Claims 18-38 are pending in the application.

Claims 18-38 have been rejected.

Applicant appeals from the rejection of claims 18-38.

IV
STATUS OF AMENDMENTS

No amendments have been filed after the rejection of claims in the Final Office Action mailed on September 20, 2007.

V
SUMMARY OF CLAIMED SUBJECT MATTER

A. Independent Claims

Claim 18

Claim 18 is directed to a method for conducting on-line commerce. *E.g.*, specification at 1, lines 5-7; *id.* page 2, lines 6-16.

The method includes providing a software-based interface. *E.g.*, specification at page 3, lines 10-20; *id.* page 7, line 15, through page 8, line 2. The software interface is configured to enable a user to selectively designate a plurality of different items to be purchased in a single search, wherein the software-based interface enables the user to selectively designate the plurality of different items without searching for each different item of the plurality of different items one item at a time. *E.g.*, specification at page 3, lines 2-9; *id.* page 3, line 21, through page 4, line 12; Figure 1, step 1.

The method also includes receiving from the user selective designations of the plurality of different items designated by the user through the interface. *E.g.*, specification at page 2, lines 6-16; *id.* page 5, line 20, through page 6, line 2; Figure 1, step 20.

The method further includes searching, during the single search, for all of said plurality of different items on a plurality of data sources. *E.g.*, specification at page 2, lines 6-16; *id.* page 3, lines 2-9; Figure 1, step 12.

The method further includes displaying information found during the single search regarding said plurality of different items. *E.g.*, specification at page 2, lines 6-16; *id.* page 3, lines 10-20; *id.* page 5, lines 1-12; *id.* page 6, line 18, through page 7, line 9.

The method further includes purchasing on-line all or some of said plurality of different items. *E.g.*, specification at page 2, lines 6-16; *id.* page 3, lines 2-20; *id.* page 5, lines 1-12; Figure 1, steps 15 and 16.

Claim 34

Claim 34 is directed to a method for conducting on-line commerce. *E.g.*, specification at 1, lines 5-7; *id.* page 2, lines 6-16.

The method includes enabling a shopper to selectively designate a shopping list comprised of a plurality of different items, to be found in a single search, wherein the step of enabling is performed so as to enable the shopper to avoid searching for each different item of the plurality of different items one item at a time. *E.g.*, specification at page 3, lines 2-9; *id.* page 3, line 21, through page 4, line 12; Figure 1, step 1.

The method also includes searching, during the single search, for each one of the plurality of different items in said shopping list on a plurality of data sources. *E.g.*, specification at page 2, lines 6-16; *id.* page 3, lines 2-9; Figure 1, step 12.

The method further includes displaying information regarding said plurality of different items found during the single search. *E.g.*, specification at page 2, lines 6-16; *id.* page 3, lines 10-20; *id.* page 5, lines 1-12; *id.* page 6, line 18, through page 7, line 9.

The method further includes simultaneously purchasing on-line all or some of said plurality of different items in said shopping list. *E.g.*, specification at page 2, lines 6-16; *id.* page 3, lines 2-20; *id.* page 5, lines 1-12; Figure 1, steps 15 and 16.

VI
GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claim 21 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claims 18-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gavarini, U.S. Patent Number 7,080,070 (“Gavarini” in this Appeal Brief) in view of Wells, U.S. Patent Number 6,711,586 (“Wells”).

VII ARGUMENT

A. Art Rejection of Independent Claim 18

To facilitate discussion, claim 18 is set forth below:

18. A method for conducting on-line commerce, comprising the steps of:

providing a software-based interface configured to enable a user to selectively designate a plurality of different items to be purchased in a single search, wherein the software-based interface enables the user to selectively designate the plurality of different items without searching for each different item of the plurality of different items one item at a time;

receiving from the user selective designations of the plurality of different items designated by the user through the interface;

searching, during the single search, for all of said plurality of different items on a plurality of data sources;

displaying information found during the single search regarding said plurality of different items; and

purchasing on-line all or some of said plurality of different items.

In rejecting claim 18 as unpatentable over Gavarini and Wells, the Final Office Action acknowledged (page 3) that Gavarini does not explicitly disclose *searching, during the single search, for all of said plurality of different items on a plurality of data sources*. The Final Office Action then asserted that Wells discloses this step in column 2, lines 6-46. Here is the cited text:

The present invention relates to a method for searching and providing information to a user. The method includes the steps of transmitting a primary selection to the user, receiving a level of interest in the primary selection from the user and obtaining a set of associated selections having a level of similarity to the primary selection determined on the basis of the level of interest, and transmitting at least a subset of the associated selections to the user.

Preferably, the obtaining step comprises searching a database to obtain the set of associated information selections. The level of similarity is preferably determined to have one of at least three different levels and a different set of associated selections is obtained depending on which level is determined.

Typically, the primary selection and at least some members, for example, each member, of the set of associated selections are characterized by a plurality of attributes and the level of similarity is determined from the absolute or relative number of attributes common to a member of the set of associated selections and the primary selection. The attributes preferably comprise at least one of text related to the associated selections or primary selection and a graphic related to the associated selections or primary selection. For example, the attributes may comprise at least one of a word, a phrase, and a keyword.

In a preferred embodiment, the primary selection relates to a primary item and each member of the set of associated selections relates to a different associated item. For example, the primary item and the associated items preferably relate to at least one of a document comprising information, an object for sale, an object for rent, and a service. The document preferably comprises at least one of HTML (hypertext markup language, DHTML (dynamic hypertext markup language), x-text, or x-HTML (extensible markup language). The object for sale preferably comprises at least one of computer software, a compact disc, a video, a book, an article of food, an automobile, a source of audio provided over the Internet, a source of video provided over the Internet, and an article of clothing. The object for rent preferably comprises at least one of a compact disc, a video, a book, or an automobile.

Wells, col. 2, lines 6-46. In these cited paragraphs, Wells does not disclose or suggest the limitations in question. The undersigned attorney has examined the remainder of Wells, but has not been able to find a disclosure or a suggestion of disclose *searching, during the single search, for all of said plurality of different items on a plurality of data sources.*

First, the items recited in the independent claim 18 have been selectively designated by the user. Claim 18, lines 2-3¹ (“receiving from the user selective designations of the plurality of different items designated by the user through the interface”); *id.* lines 7-8 (“receiving from the user selective designations of the plurality of different items designated by the user through the interface”). In contrast, Wells’s “selections” are not selected by the user. In the cited text, Wells teaches that the primary selection is transmitted to the user – not received from the user. Wells, col. 2, lines 7-13. The primary selection also refers to a single item – not to a plurality of different items.

Id. Wells's user then indicates a level of interest in the primary selection. *See id.* A set of associated selections in Wells is determined and a subset of the associated selections is transmitted to the user.

Id. The associated selections are not made by the user, and therefore they are not received from the user.

The rest of the Wells document is to the same effect. In an example provided by Wells, "First Web page 100 is configured to provide the user with information that relates to an item, such as an object, document, or service, that may be of interest to the user." Wells, col. 5, lines 54-57. The user is thus provided with information that relates to a single item, instead of the user providing selections of multiple items. Later, Wells teaches that

the primary information selection and the association information selections may be selected randomly from the database. Alternatively, the selections 210, 215a-f may be obtained from a subset of the database relating to a particular subject or topic. Preferably, however, the first associated selections are selected to have a range of different association levels with respect to the first primary selection such that the user is presented with selections relating to different types of information.

Wells, col. 11, lines 50-59. Note that Wells expressly defines *selections* thus:

The term selections is used to indicate that the information is represented on Web page 100 by a selectable button as described above. Additionally, unless it is specified otherwise, the term selections is meant to comprise both the primary selection and associated selections of a Web page of the present invention.

Wells, col. 6, lines 3-8. Wells's selections are not selections of the user, but rather selections from which the user is allowed or enabled to select.

Wells does not disclose or suggest receiving from the user selective designations of the plurality of different items designated by the user. More specifically, Wells does not disclose or

¹ Claim line numbers refer to the claim as shown at the beginning of this subsection.

suggest a plurality of different items designated by the user. It necessarily follows that Wells does not disclose searching, during the single search, for all of *said plurality of different items*.

Second, Wells does not disclose searching on a plurality of *data sources*. The Final Office action asserted (page 3) “that multiple web pages can be construed as multiple data sources.” There is no basis for such construction. A web page is generally understood as a document on the World Wide Web consisting of an HTML file, with associated files for graphics and scripts, in a particular directory on a particular machine; usually a web page contains links to other web pages. *See, e.g.,* MICROSOFT COMPUTER DICTIONARY 564 (Microsoft Press, 5th ed., 2002). The actual source of the information on Wells’s web pages is a database, as Wells states in column 11, lines 50-59, quoted in the immediately preceding page. Wells does not describe or suggest more than one database used as a source.

Third, Wells does not disclose a single search for all the selected items. Wells describes, *inter alia*, a plurality of iterative searches based on a user’s expressed level of interest in an item. *See, e.g.,* Wells, the Abstract. If a search produces a selection of particular interest to the user (called a *terminal selection*), the user can rent or buy the selection, but apparently only one selection at a time can be a terminal selection. Here is how the process is described:

In certain cases, one of the initially provided selections may be of particular interest to the user. Such a selection, i.e., one that satisfies a query of the user, is defined as a terminal selection. In general, the Web page is configured to provide the user with further options once a terminal selection has been found. For example, the Web page includes a selectable rental button 120 and a selectable purchase button 125 configured to allow the user to request information regarding, for example, the sale or rental of an item relating to a terminal selection. As before, when a user clicks on rental button 120 or purchase button 125, a request is received by the server to transmit information to client computer 11 related to this request. Thus, the present invention provides a method for the user to purchase or rent any of the selections such as, for example, the movie HALLOWEEN 110e.

Wells, col. 6, lines 25-40. In this quoted paragraph Wells speaks of one of the initially provided selections, which the user can purchase by clicking on the purchase button 125.

Fourth, it appears acknowledged that in rejecting claim 18, the providing interface limitation was not considered. Instead, the Final Office Action (page 4) regarded the interface an optional or conditional element that “can always be omitted.” The reason given was that “[a]s a matter of linguistic precision, optional elements (such as ‘configured to enable’) do not narrow the claim”

There is neither linguistic nor legal justification for such failure to consider claim limitations. In its ordinary modern meaning, the verb *configure* means “Put together in a certain configuration; shape, fashion.” OXFORD UNIVERSITY PRESS, THE NEW SHORTER OXFORD *ENGLISH DICTIONARY* (CD-ROM ed. 1996). In computer art context, it means “Interconnect or interrelate (a computer system or elements of it) so as to fit it for a designated task.” *Id.* The word *configured* consequently means put together in a certain configuration, interconnected or interrelated to fit it for a particular task.

The Final Office Action cited MPEP § 2106(II)(C) to support the assertion that the *interface configured to enable* is optional and not a limitation. We understand this as a reference to the “adapted to” and “adapted for” language, which, according to the MPEP, “may raise a question as to the limiting effect of the language in a claim.” MPEP § 2106(II)(C). Unfortunately, the Final Office Action is devoid of any factual analysis of the specific recitations in the claims in issue here in view of the specification. And without such analysis, a *prima facie* case of unpatentability cannot be made. Instead of providing a factual analysis, the Final Office Action apparently applied a rigid rule that presence of certain language in a claim automatically renders the recitations related to the language non-limiting. This rigid rule is in stark contrast to the actual permissive verbiage used in

MPEP § 2106(II)(C), to the effect that *adapted* may raise a question as to the limiting effect. Why was the “question as to the limiting effect” raised here in the first place? And why was it answered to deny the limiting effect? The Final Office Action does not provide any answers to these queries.

The honorable Board of Appeals can take administrative notice of thousands upon thousands of issued and litigated patent claims that use “configured” and similar phrases with limiting effect.

Turning finally to the motivation for combining Gavarini and Wells, the Final Office Action conclusively asserted (page 3) that the motivation to combine would be “in order to create a more efficient searching system by combining searches.” This statement is so broad that it is meaningless in context. Moreover, it appears that this statement was derived from Applicant’s disclosure. See, for example, specification, page 1, line 14, through page 2, line 3. Motivation for combining, however, may not be taken from Applicant’s disclosure. MPEP § 2143 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)).

The Patent and Trademark Office has the burden of making a *prima facie* case of obviousness under 35 U.S.C. § 103. *E.g.*, *In re Mayne*, 104 F.3d 1339, 1342, 41 U.S.P.Q.2d 1451, 1454 (Fed. Cir. 1997); MPEP § 2142. One of the requirements for establishing a *prima facie* case of obviousness is a showing that the combination of prior art references teaches or suggests all the claim limitations. MPEP § 2143. In this case, the references do not disclose or suggest a single search for a plurality of different items selected by a user on a plurality of data sources. Another requirement is some articulated analysis explaining why a combination of references would have been made. See *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. ___, 127 S. Ct. 1727, 167 L. Ed. 2d 705, 82 U.S.P.Q.2D (BNA) 1385 (2007) (slip opinion at 14). Here, the Final Office Action fails to provide

such analysis. At least for these reasons, Applicant respectfully submits that Gavarini and Wells do not render claim 18 unpatentable.

B. Art Rejection of Independent Claim 34

This claim recites limitations similar, analogous, or identical to those of claim 18, and stands rejected as being unpatentable over Gavarini in view of Wells, the same ground as was applied to claim 18. Applicant incorporates here all arguments set forth in relation to claim 18 under the immediately preceding subheading.

Additionally, claim 34 recites simultaneously purchasing on-line all or some of said plurality of different items. Simultaneous on-line purchase of at least some items requires simultaneous purchase of at least two different items. This is so because (2) *some items* is phrased in the plural form, and (2) *simultaneously* would be meaningless in case of a single item, particularly in view of the specification. The references do not disclose or suggest simultaneous purchasing of items.

Applicant respectfully submits that claim 34 is patentable over the references at least for these reasons.

C. Art Rejection of Dependent Claim 21

Claim 21 depends from claim 18 and recites the following additional limitations:

the software-based interface is further configured to enable the user to selectively specify at least one of the plurality of data sources to be searched, said at least one of the plurality of data sources is searchable through a first website, another data source of the plurality of data sources is searchable through a second website, and the first website is different from the second website.

In rejecting this claim under section 103, the Final Office Action cited Gavarini's Abstract as

disclosing the additional limitations. Here is the text of that Abstract:

An electronic commerce system provides various features for assisting customers in locating items and generating orders from a merchant's electronic catalog, and for assisting customers and merchants in communicating about such orders. A user-definable categories feature allows customers and/or merchants to define search queries for searching the electronic catalog, and to store these search queries under user-defined category names for subsequent use.

Gavarini, Abstract. This text refers to a single source – the merchant's electronic catalog; it does not contain any mention of selectively specifying at least one of a plurality of data sources to be searched.

The references do not disclose an interface configured to enable the user to specify at least one of the data sources for the single search for multiple items. Moreover, as discussed in more detail above in relation to claim 18, the Final Office Action apparently acknowledged that the limitations of interface configured in a certain way were disregarded. Applicant respectfully submits that at least for these reasons a *prima facie* case of obviousness has not been made, and that claim 21 is separately patentable over the references.

D. Art Rejection of Dependent Claim 28

This claim depends from claim 18 and specifies that the step of searching includes the following limitations:

searching certain data sources of the plurality of data sources in a prioritized order specified by the user.

In rejecting claim 28, the Final Office Action cited Gavarini, column 2, lines 45-50 as disclosing the additional step limitations. Here is the cited text:

Specifically, regardless of the browsing mode (alphabetic browsing,

category-based browsing, search, etc.), whenever the user views an item or a list of items, each such item is displayed in conjunction with a “quantity” field which indicates the number of that item currently selected for purchase.

Gavarini, col. 2, lines 45-50. This text does not contain any mention of searching certain data sources of the plurality of data sources in a prioritized order specified by the user.

Applicant respectfully submits that a *prima facie* case of obviousness has not been made also for this reason, and that claim 28 is separately patentable over the references.

E. Art Rejection of Dependent Claim 33

This claim depends from claim 18 and specifies that the step of purchasing includes the following limitations:

placing a single order for all of the plurality of different items to be purchased, at corresponding data sources, selected and approved by the user.

In rejecting claim 33, the Final Office Action cited Gavarini, Figure 25A as disclosing the additional step limitations. Gavarini’s “FIG. 25A illustrates a ‘screen capture’ depiction of an electronic commerce system utilizing a messaging system between a merchant and a customer, wherein the message is linked to an order page.” Gavarini, col. 1, lines 56-59. The Figure

shows a screen display produced by the merchant application 53, allowing the merchant 74 to view the customer's 72 order. On this screen, the merchant 74 can update the status of the order (for instance, from “accepted” to “shipped”), by changing the value in the pull-down menu 211 and then selecting the “Update, then view next” button 213. In addition, the merchant 74 can view that latest message 215 from the customer 72, send a message to the customer, using the message input area 217. Finally, the merchant 74 can view a history or log of all messages relating to the current order, by pressing the “History” button 219.

Gavarini, col. 12, lines 16-27. For convenience, the Figure appears on the page following the end of this subheading. It does not disclose or suggest placing a single order for all of the plurality of

different items. Apparently, the Figure shows only a single product code (ACHAI-HELEN-NV-12/750 NV), a single product name (Achaia Clauss St. Helena), and a single price per item (\$60.00).

There is no mention of more than one item, or of placing a single order for a plurality of different items. Applicant respectfully submits that at least for these reasons a *prima facie* case of obviousness has not been made, and that claim 28 is separately patentable over the references.

MERCHANT ADMINISTRATIVE FUNCTIONS

| CLIENTS <u>SELECT</u> APPLICATIONS <u>SELECT</u> <u>WAITING</u> ORDERS <u>NEW</u> <u>ALL</u> <u>TRACK</u> STATISTICS <u>SELECT</u> PER MONTH PER YEAR PER CLIENT PER STATE SERVICES <u>NEW MAIL</u> <u>OLD MAIL</u> <u>SEND MAIL</u> <u>CATALOG</u> SEARCH <u>PRODUCTS</u> <u>ORDERS</u> <u>EVERYTHING</u> COMPANY <u>PERSONNEL</u> <u>PREFERENCES</u> <u>HELP</u> <u>SIGN OFF</u> | ORDER DETAILS <table style="width: 100%;"> <tr> <td style="width: 20%;">CLIENT</td> <td style="width: 20%;">Sandi Belcher</td> <td style="width: 20%;">ORDER NAME</td> <td style="width: 40%;">ORDER 06/12/99</td> </tr> <tr> <td>CLIENT CODE</td> <td>BELCH</td> <td>DATE PLACED</td> <td>06/12/99</td> </tr> </table> <table style="width: 100%;"> <tr> <td style="width: 40%; text-align: center;">SHIP TO:</td> <td style="width: 60%; text-align: center;">BILL TO:</td> </tr> <tr> <td>COMPANY</td> <td>Sandi Belcher</td> </tr> <tr> <td>NAME</td> <td>Harry, Bigbucks</td> </tr> <tr> <td>ADDRESS</td> <td>Box 50</td> </tr> <tr> <td></td> <td>St. Helena, CA 94574</td> </tr> <tr> <td></td> <td>UNITED STATES</td> </tr> <tr> <td>EMAIL</td> <td>harry@superliquor.com</td> </tr> <tr> <td>PHONE</td> <td>707.963.2496</td> </tr> <tr> <td>FAX</td> <td>707.963.3429</td> </tr> </table> <table style="width: 100%;"> <tr> <th style="width: 20%;">PRODUCT CODE</th> <th style="width: 20%;">PRODUCT NAME</th> <th style="width: 10%;">QUAN</th> <th style="width: 10%;">STOCK</th> <th style="width: 10%;">UNIT</th> <th style="width: 10%;">PRICE</th> <th style="width: 10%;">ITEM</th> <th style="width: 10%;">TOTAL</th> </tr> <tr> <td>ACHAI-HELEN-NV-12/750 NV</td> <td>Achaia Clouss St. Helena</td> <td>7</td> <td>6</td> <td>CASE</td> <td>60.00</td> <td></td> <td>420.00</td> </tr> <tr> <td colspan="7" style="text-align: right;">UNADJUSTED TOTAL</td> <td>420.00</td> </tr> <tr> <td colspan="7" style="text-align: right;">ADJUSTMENT TO FINAL TOTAL COST</td> <td>420.00</td> </tr> <tr> <td colspan="7" style="text-align: right;">FINAL TOTAL</td> <td>420.00</td> </tr> </table> <div style="border: 1px solid black; padding: 5px; margin-bottom: 10px;"> <p>215 LAST INSTRUCTIONS FROM THE CLIENT: I NEED THIS FAST!</p> <p style="text-align: right;">HISTORY</p> </div> <div style="border: 1px solid black; padding: 5px; margin-bottom: 10px;"> <p>217 MESSAGE FROM: Alw</p> </div> <div style="display: flex; justify-content: space-between;"> <div style="width: 40%;"> <p>CARRIER UPS</p> <p>TRACKING NUMBER 1zw248x12210553279</p> <p>STATUS: ACCEPTED</p> </div> <div style="width: 40%;"> <p>SHIPPING DATE MM/DD/YYYY </p> <p>DISPLAY TRACKING DETAILS</p> <p>UPDATE THEN VIEW NEXT</p> </div> </div> | CLIENT | Sandi Belcher | ORDER NAME | ORDER 06/12/99 | CLIENT CODE | BELCH | DATE PLACED | 06/12/99 | SHIP TO: | BILL TO: | COMPANY | Sandi Belcher | NAME | Harry, Bigbucks | ADDRESS | Box 50 | | St. Helena, CA 94574 | | UNITED STATES | EMAIL | harry@superliquor.com | PHONE | 707.963.2496 | FAX | 707.963.3429 | PRODUCT CODE | PRODUCT NAME | QUAN | STOCK | UNIT | PRICE | ITEM | TOTAL | ACHAI-HELEN-NV-12/750 NV | Achaia Clouss St. Helena | 7 | 6 | CASE | 60.00 | | 420.00 | UNADJUSTED TOTAL | | | | | | | 420.00 | ADJUSTMENT TO FINAL TOTAL COST | | | | | | | 420.00 | FINAL TOTAL | | | | | | | 420.00 |
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| COMPANY | Sandi Belcher | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| NAME | Harry, Bigbucks | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
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| | UNITED STATES | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
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| FAX | 707.963.3429 | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| PRODUCT CODE | PRODUCT NAME | QUAN | STOCK | UNIT | PRICE | ITEM | TOTAL | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| ACHAI-HELEN-NV-12/750 NV | Achaia Clouss St. Helena | 7 | 6 | CASE | 60.00 | | 420.00 | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| UNADJUSTED TOTAL | | | | | | | 420.00 | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| ADJUSTMENT TO FINAL TOTAL COST | | | | | | | 420.00 | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| FINAL TOTAL | | | | | | | 420.00 | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |

FIG. 25A

F. Art Rejection of Dependent Claim 36

Claim 36 depends from independent claim 34 and specifies that the purchasing step includes the following limitations:

placing a single order for all items on the shopping list, at a corresponding data source, selected and approved by the user.

Applicant respectfully submits that claim 36 is separately patentable at least for the same reason as is discussed in relation to dependent claim 33 under the immediately preceding subheading.

G. Art Rejection of Dependent Claim 38

This claim depends from claim 18 and recites the following additional limitations:

wherein the software-based interface is further configured to:
present to the user a list of items required for a project specified by the user;
and
allow the user to edit the list of items, thereby obtaining a list of the plurality of different items.

The Final Office Action asserted that “[c]laim 38 is in parallel with claim 27 and is rejected for at least the same reasons.” Regarding claim 27, the Final Office Action cited Gavarini’s Figure 14 as disclosing all additional limitations.

Gavarini’s “FIGS. 14-18 show ‘screen capture’ depictions of an electronic commerce system utilizing customer configurable dynamic categories.” Gavarini, col. 1, lines 47-49. The Figure

is an example screen display depicting the dynamic, user-defined category feature of customer application 51. The screen depicts two categories, 162, 164, along with the number of items 166, 168 contained within each respective category. The categories

may be either customer-defined, such as the category referenced by 164, or merchant defined, as is the category referenced by 162. In the preferred implementation, the customer application does not distinguish between the merchant-defined category 162 and the customer-defined category 164 when displaying categories, but an alternative implementation might visually distinguish the two types of categories. Both of the category names 162, 164 are hyperlinks. Clicking on either category will produce a screen displaying the items within that category. In addition, the customer 72 can choose to create a new category using the appropriate button 170, delete an existing category using the respective button 172 or reorder the categories using the corresponding button 174. Finally, the customer 72 can access the other features of the customer application 51 using the navigation bar 119.

Gavarini, col. 9, lines 14-33. The Figure appears on the next page. It does not disclose or suggest, *inter alia*, presenting to the user a list of items required for a project specified by the user. Applicant respectfully submits that at least for this reason a *prima facie* case of obviousness has not been made, and that claim 38 is separately patentable over the references.

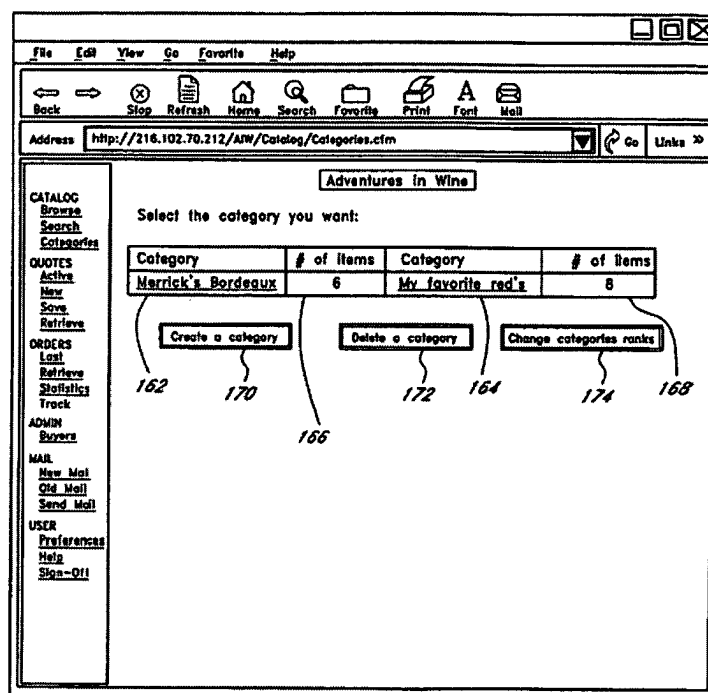


FIG. 14

H. Enablement Rejection of Dependent Claim 21

This claim was also rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In particular, the Final Office Action asserted that “[t]he specification fails to enable a plurality of distinct data sources searchable through a website.”

The application describes “conducting commercial transactions over the Internet, whereby a shopper can simultaneously search for a plurality of items on a plurality of websites in a single search.” Specification, page 2, lines 6-8 (emphasis added). The application also teaches that

The system and method of the present invention is implemented by software. The software is used in conjunction with a website that the shopper would visit to shop for items to be purchased. The software presents a series of on-screen prompts in response to which the shopper specifies the items to be searched and specifies information/preferences and/or answers questions regarding the items so that a search can be conducted for such items. The software causes a search to be conducted on websites specified by the shopper and/or on a selectively alterably set of default websites specified in the software.

Specification, page 3, lines 10-17 (emphasis added). Furthermore, references to websites to be searched appear throughout the specification.

The Office “has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention.” MPEP § 2164.04 (*citing In re Wright*, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993)). “[I]t is incumbent upon the Patent Office, whenever a rejection on this basis [enablement] is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.” MPEP § 2164.04 (*quoting In re Marzocchi*, 439 F.2d 220, 224, 169 U.S.P.Q. 367, 370 (CCPA

1971)). Here, the Final Office Action made a bare assertion that the claim is not enabled. The Final Office Action in this case does not contain even of shred of evidence, analysis, reasoning, or explanation in support of the enablement rejection.

At least for the above reasons Applicant respectfully submits that a *prima facie* case of lack of enablement of claim 21 has not been made, and the claim meets the enablement requirement of section 112, first paragraph.

I. Rejections of Remaining Dependent Claims

Dependent claims not specifically addressed in the above arguments should be patentable at least for the reasons discussed in relation to their respective base claims and intervening claims, if any.

VIII
CONCLUSION

For the foregoing reasons, Applicant-Appellant respectfully submits that all pending claims are patentable and requests reversal of the rejections.

Respectfully submitted,

Dated: February 21, 2008

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CLAIMS APPENDIX

The following is a listing of the claims in the application. All claims have been rejected and are involved in this Appeal.

18. A method for conducting on-line commerce, comprising the steps of:

providing a software-based interface configured to enable a user to selectively designate a plurality of different items to be purchased in a single search, wherein the software-based interface enables the user to selectively designate the plurality of different items without searching for each different item of the plurality of different items one item at a time;

receiving from the user selective designations of the plurality of different items designated by the user through the interface;

searching, during the single search, for all of said plurality of different items on a plurality of data sources;

displaying information found during the single search regarding said plurality of different items; and

purchasing on-line all or some of said plurality of different items.

19. The method according to Claim 18, wherein at least one of the plurality of data sources is a website.

20. The method according to Claim 18, wherein at least one of the plurality of data sources is a

database.

21. The method according to Claim 18, wherein:

the software-based interface is further configured to enable the user to selectively specify at least one of the plurality of data sources to be searched, said at least one of the plurality of data sources is searchable through a first website, another data source of the plurality of data sources is searchable through a second website, and the first website is different from the second website.

22. The method according to Claim 18, wherein at least one of the plurality of data sources is a default data source specified by the user.

23. The method according to Claim 18, wherein the step of displaying information includes the step of:

displaying search results of the single search on a display device for viewing by the user, the search results providing information regarding all of said plurality of different items searched.

24. The method according to Claim 23, wherein if a particular one of the plurality of data sources that was searched does not have a particular one of the plurality of different items available for sale, that particular data source indicates if any of the other plurality of data sources searched has the item available for sale.

25. The method according to Claim 23, wherein the step of displaying search results includes the

step of:

displaying in a plurality of lists the information found during the single search, each one of the plurality of lists displaying search results from a different one of the plurality of data sources searched.

26. The method according to Claim 25, wherein the step of purchasing includes:

providing a software-based interface configured to enable the user to place one order for purchasing all or some of said plurality of different items.

27. The method according to Claim 18, wherein the software-based interface is further configured to enable the user to specify display criteria whereby the information found in the search is displayed according to the display criteria specified by the user.

28. The method according to Claim 18, wherein the step of searching comprises the step of:
searching certain data sources of the plurality of data sources in a prioritized order specified by the user.

29. The method according to Claim 18, further comprising the steps of:
displaying a list of preferred data sources on a display device;
prompting the user to edit the list of preferred data sources;
receiving from the user input provided in response to the step of prompting; and
editing the list of preferred data sources in accordance with the input provided by the user in

response to the step of prompting to determine the plurality of data sources;

wherein the steps of displaying the list of preferred data sources, prompting, receiving, and editing are performed before the step of searching.

30. The method according to Claim 18, wherein the plurality of different items comprises a shopping list.

31. The method according to Claim 18, further comprising the step of:
prompting the user to exclude at least one item from the plurality of different items before the step of searching.

32. The method according to Claim 18, wherein the plurality of different items includes different types of items.

33. The method according to Claim 18, wherein the step of purchasing includes the step of:
placing a single order for all of the plurality of different items to be purchased, at corresponding data sources, selected and approved by the user.

34. A method for conducting on-line commerce, comprising the steps of:
enabling a shopper to selectively designate a shopping list comprised of a plurality of different items, to be found in a single search, wherein the step of enabling is performed so as to enable the shopper to avoid searching for each different item of the plurality of different items one

item at a time;

searching, during the single search, for each one of the plurality of different items in said shopping list on a plurality of data sources;

displaying information regarding said plurality of different items found during the single search; and

simultaneously purchasing on-line all or some of said plurality of different items in said shopping list.

35. The method according to Claim 34, further comprising the steps of:

displaying to the shopper a list of data sources to be searched;

prompting the shopper to edit the list of data sources;

in response to the step of prompting, receiving from the shopper input for editing the list of data sources;

before the step of searching, editing the list of data sources in accordance with the input to create a specified data sources list, the specified data sources list comprising at least one record for each data source of the plurality of data sources.

36. The method according to Claim 34, wherein the purchasing step includes the step of:

placing a single order for all items on the shopping list, at a corresponding data source, selected and approved by the user.

37. The method according to Claim 34, wherein if a particular one of the plurality of data sources

that was searched does not have a particular one of the plurality of items available for sale, that particular data source indicates if any of the other plurality of data sources has the item available for sale.

38. The method according to Claim 18, wherein the software-based interface is further configured to:

present to the user a list of items required for a project specified by the user; and

allow the user to edit the list of items, thereby obtaining a list of the plurality of different items.

EVIDENCE APPENDIX

No evidence has been submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132. No evidence has been entered in the record by the Examiner and relied upon by Appellant in this Appeal.

RELATED PROCEEDINGS APPENDIX

Applicant-Appellant and the undersigned legal representative do not know of any other appeal, interference, or judicial proceeding that is related to, directly affects, is directly affected by, or has a bearing on the decision of the Board of Patent Appeals and Interferences in this Appeal.